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OFFICE OF PETITIONS

In re Application of

Belson

Application No. 09/992,526

Filing Date: 13 November, 2001

Attorney Docket No. BEL1015U

DECISION

This is a decision on the petition filed on 18 March, 2005, alleging unavoidable delay under 37 C.F.R. §1.137(a), and, in light of the allegations considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is **GRANTED**, and the petition under 37 C.F.R. §1.137(a) is **DISMISSED as moot**.

BACKGROUND

The record reflects that:

- it appeared that Petitioner failed to reply timely and properly to a non-final Office action mailed on 15 March, 2004, with reply due absent extension of time on or before 15 June, 2004;
- the application could have gone abandoned after midnight 15 June, 2004;
- however, on 20 September, 2004 (over a 15 September, 2004, certificate of mail on the transmittal), Petitioner filed a reply in the form of an amendment along with a request and

fee for a three- (3-) month extension of time—and, as Petitioner points out—the documentation of Office receipt of the papers and those events described is evidenced in Office records such as PAIR and in Office finance records (a copy of the latter has been placed into the file);

- nonetheless, the Office mailed the Notice of Abandonment on 21 September, 2004;
- on 18 March, 2005, Petitioner filed the instant petition, with fee, a copy of the reply in the form of an amendment and documents evidencing Office receipt of the reply (“Workflow incoming amendment IFW”).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to “revive an application if the delay is shown to the satisfaction of the Commissioner to have been “unavoidable.” 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not

¹ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁴ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁷

Petitioner evidences timely Office receipt of the reply over a certificate of mail and accompanied by request and fee for extension of time.

CONCLUSION

Because Petitioner satisfied the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 hereby is **granted**, and the 21 September, 2004, Notice of Abandonment hereby is vacated; the petition under 37 C.F.R. §1.137(a) is **dismissed as moot**, and the petition fee (\$250.00) is waived and is refunded via Treasury check.

The instant application is forwarded to the Technology Center 3700 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
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Office of Petitions

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁷ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).